

REMARKS

Claims 1 through 10 are pending in this Application. Independent claims 1 and 7 have been amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure noting, for example, the depicted embodiments and related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 1 through 10 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Bost et al.

In the statement of the rejection the Examiner referred to Figs. 18 and 19 of Bost et al., asserting that elements of the claimed invention appear in the depicted structure. They don't. But the Examiner took it upon himself to divide main line 191 into two separate lines, 191a and 191b. Having thus reconstructed the invention of Bost et al., the Examiner asserted that lines 191a and 191b correspond to the first and second groove portions of the claimed invention, respectively. The Examiner then went further and carved up guard ring 199 into what the Examiner conveniently referred to as third groove portions 191c and 191d. This rejection is traversed.

The factual determination of lack of novelty requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002).

Furthermore, when imposing a rejection under 35 U.S.C. § 102, particularly where it is not apparent that an applied reference identically discloses each and every feature of a claimed invention, the Examiner is required to specifically point out where an applied reference does identically disclose each and every feature of a claimed invention. That burden is not discharged by redrawing illustrated structures to conveniently create something that does not exist. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). Indeed, there are significant differences between the claimed semiconductor devices and the device disclosed by Bost et al. that scotch the factual determination that Bost et al. disclose a semiconductor device identically corresponding to that claimed.

Applicants submit that the Examiner's interpretation of the claimed invention vis-à-vis Bost et al. is legally erroneous. This is because claims must be construed through the eyes of one having ordinary skill in the art in a manner that is consistent with the written description of the specification. *Dayco Products, Inc. v. Total Containment, Inc.*, 258 F.3d 1317, 59 USPQ2d 1489 (F.C. 2001); *In re Cortright*, 165 F.3d 1353, 49 USPQ2d 1464 (Fed. Cir. 1999); *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). It is inconceivable that one having ordinary skill in the art would have interpreted the claimed invention, particularly in light of and consistent with the written description of the specification, as readable on Bost et al. in the manner suggested by the Examiner. This is because the Examiner's fictitious elements 191a, 191b, 191c and 191d do not exist in the device disclosed by Bost et al., because **they are not separate from main line 191**.

At any rate, in order to expedite prosecution, **claims 1 and 7** have been amended for clarification. Notably, **claim 1** recites that the strip-like first and second groove portions are separate and spaced apart and that they are positioned between a first side surface of the semiconductor element and peripheral edge of the interlayer insulating film. No such structure is disclosed or suggested by Bost et al., who merely disclose a single main line 191.

Claim 7 has been clarified by reciting that the first and second groove portions contiguously extend along the first side surface of the semiconductor element. Not so in the structure disclosed by Bost et al. Indeed, advertizing to Fig. 19 of Bost et al., cross members 192 **do not contiguously extend along a peripheral edge of electrically active region 45**. Accordingly, a clear structural difference exists between the device defined in claim 7 and the device disclosed by Bost et al. Moreover, this difference is functionally significant because in accordance with the device in claim 7, it is possible to obtain a double seal ring structure by the metal filling of the first and second groove portions in any of the positions along the first side surface of the semiconductor element.

The above argued structural differences between the claimed semiconductor devices and the device disclosed by Bost et al. undermine the factual determination that Bost et al. disclose a semiconductor device identically corresponding to those claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1 through 10 under 35 U.S.C. § 102 for lack of novelty as evidenced by Bost et al. is not factually viable and, hence, solicit withdrawal thereof.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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